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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,797	08/25/2003	Akihiro Matsuya	00862.023188.	1223

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FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER

GELAGAY, SHEWAYE

ART UNIT	PAPER NUMBER
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2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/646,797

Applicant(s)

MATSUYA, AKIHIRO

Examiner

Shewaye Gelagay

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. Claims 1-10 have been examined.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a "program product" not embodied in a tangible medium. This amounts to functional descriptive material which is non-statutory. See MPEP 2106 "Functional Descriptive Material".

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2137

5. Claims 1, 6-7 and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Berson et al. (hereinafter Berson) U.S. Patent Number 6,938,154.

As per claims 1, 7 and 9-10:

Berson teaches an authentication method of an image processing system in which a host computer and an image processing apparatus are connected to a network, information in the image processing apparatus being processable in accordance with a remote operation from the host computer, comprising:

a first authentication step of authenticating the image processing apparatus when the host computer is to remotely operate information in the image processing apparatus; (col. 4, line 26-col. 5, line 3) and

a second authentication step of performing an authentication process for an operation with respect to the information on the basis of a code stored in the host computer. (col. 4, line 26-col. 5, line 3)

As per claim 6:

Berson teaches all the subject matter as discussed above. In addition Berson further discloses a method wherein the operation with respect to the information is at least one of download, browsing, printing, and transfer. (col. 4, lines 26-35)

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

Art Unit: 2137

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berson et al. (hereinafter Berson) U.S. Patent Number 6,938,154 in view of Matasushima U.S. Patent Number 7,117,493.

As per claims 2 and 8:

Berson teaches all the subject matter as discussed above. Both references do not explicitly disclose wherein the authentication process is executed by add-on software downloaded from the image processing apparatus. Matasushima in analogous art, however, discloses wherein the authentication process is executed by add-on software downloaded from the image processing apparatus. (col. 4, lines 1-31; col. 8, lines 38-55) Therefore it would have been obvious to one ordinary skill in the art to modify the method disclosed by Berson with Matasushima in order to have a system to legitimately and efficiently acquire and execute software after the image processing device is activated. (col. 1, lines 45-54; Matasushima)

8. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berson et al. (hereinafter Berson) U.S. Patent Number 6,938,154 in view of Matasushima U.S. Patent Number 7,117,493 and further in view of Okazaki et al. (hereinafter Okazaki) U.S. Patent Number 7,158,657.

As per claims 3-4:

The combination of Berson and Matasushima teaches all the subject matter as discussed above. Both references do not explicitly disclose a method

Art Unit: 2137

wherein the authentication process is performed using a dictionary which defines codes stored in the host computer and operations with respect to the information. Okazaki in analogous art, however, discloses wherein the authentication process is performed using a dictionary which defines codes stored in the host computer and operations with respect to the information. (figure 23, item 114; col. 18, lines 25-28) Therefore it would have been obvious to one ordinary skill in the art to modify the method disclosed by Berson and Matasushima with Okazaki in order to collate the operations with registered operation in the authentication server. (col. 1, lines 45-54; Matasushima)

As per claim 5:

The combination of Berson, Matasushima and Okazaki teaches all the subject matter as discussed above. In addition Matasushima further discloses wherein an address of the authentication device on the network is determined by add-on software. (col. 4, lines 1-31; col. 8, lines 38-55)

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The

Art Unit: 2137

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shewaye Gelagay



EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER